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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/599,027	06/22/2000	Nagayoshi Ichikawa	016887/0999	8692

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FOLEY AND LARDNER
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EXAMINER

PALABRICA, RICARDO J

ART UNIT	PAPER NUMBER
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3641

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/599,027

Applicant(s)

ICHIKAWA ET AL.

Examiner

Rick Palabrica

Art Unit

3641

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 05 January 2004 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
(a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ they raise the issue of new matter (see Note below);
(c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____

3. ☐ Applicant's reply has overcome the following rejection(s): _____.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☐ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____

Claim(s) objected to: _____

Claim(s) rejected: _____

Claim(s) withdrawn from consideration: _____

8. ☐ The drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

MICHAEL J. CANONE
SUPERVISORY PATENT EXAMINER

Continuation of 5. does NOT place the application in condition for allowance because:

Applicant's arguments are not convincing for the following reasons:

1. Applicant alleges that the Hettiarachchi references, which the Examiner cited for the 35 U.S.C. 102(b) rejections, teach away from forming TiO₂ prior to introduction into feedwater of the reactor. The Examiner disagrees because MPEP 2131.05 (Nonanalogous Art) states:

"Arguments that the alleged anticipatory prior art is nonanalogous art' or teaches away from the invention' or is not recognized as solving the problem solved by the claimed invention, [are] not germane' to a rejection under section 102." *Twin Disc, Inc. v. United States*, 231 USPQ 417, 424 (Cl. Ct. 1986) (quoting *In re Self*, 671 F.2d 1344, 213 USPQ 1, 7 (CCPA 1982)). A reference is no less anticipatory if, after disclosing the invention, the reference then disparages it. The question whether a reference "teaches away" from the invention is inapplicable to an anticipation analysis. *Celeritas Technologies Ltd. v. Rockwell International Corp.*, 150 F.3d 1354, 1361, 47 USPQ2d 1516, 1522-23 (Fed. Cir. 1998).

2. Applicant also alleges that the amount of TiO₂ available in the Hettiarachchi method "will be too small to perform the corrosion reduction function." The Examiner disagrees because the features upon which the applicant relies are not recited in rejected claim 10. Note that claim 10 does not recite any specific amount or concentration of TiO₂. Therefore, any amount of TiO₂, even a single atom, will control (and cannot be prevented from controlling) to some degree the corrosion potential of the reactor. Any amount of TiO₂ would read on the claim. Although the claims are interpreted in light of the specification, limitations from the specification are not will read into the into said claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

3. The use of TiO₂ coating to mitigate corrosion of reactor structures is an old art. For example, Skarpelos et al. (U.S. 5,028,384) teach that corrosion control in a nuclear reactor by addition of hydrogen results in potential increases in radiation exposure of personnel because hydrogen promotes increase production of nitrogen-16 (see paragraph bridging columns 1 and 2). To solve this problem, they teach surfacing or plating structural members in the reactor, e.g., the reactor pressure vessel with a catalytic oxidizing metal such as titanium dioxide (see column 5, line 5+). The term, "surfacing" or "plating" means providing the titanium dioxide coating prior to the use of the component, e.g., during the manufacturing or before the installation stage. Such coating process is clearly even before the feedwater is introduced into the reactor during its initial startup. The TiO₂ coating in Skarpelos et al. cannot be prevented from acting in the same manner as the claimed coating in applicant's claim.